

REMARKS

Claims 1 – 16 and 30 – 38 have been examined and stand rejected under 35 U.S.C. §102(e) as anticipated by U.S. Pat. No. 7,216,106 (“Buchanan”). The rejections are respectfully traversed.

First, each of the independent claims includes an element requiring that the image to have been generated as “part of a transaction at a point of sale.” The Office Action asserts that “deposit at a facility such as home or office [not bank] or computer-based software used at locations remote from financial institution offices for capturing deposit or remote location of businesses inherently retailing POS” (Office Action, p. 3, emphasis added). Applicant interprets the Office Action to mean that depositing at a remote location inherently teaches being part of a transaction at a point of sale. Applicant respectfully disagrees. As an initial matter, it is respectfully noted that the limitation states “at a point of sale” and is not limited to “retailing POS.”

“To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference.’” MPEP 2112.IV, *citing In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 – 51 (Fed. Cir. 1999). Being part of a transaction at a point of sale is not necessarily present in depositing at a remote location. For example, depositing a regular student loan payment at a remote location may not involve a transaction at a point of sale at all. Hence, the limitation of being “part of a transaction at a point of sale” is not necessarily present in Buchanan and the Office Action has failed to establish inherency.

Second, Claim 3 requires that the electronic package received at a first institution from a presenter comprises a reference to a location within a depository. The Office Action appears to argue “storing and item numbering information on the remote site processor” as somehow teaching this limitation. Office Action, p. 3. However, there is no teaching at the cited passages that item numbering information can be used as a reference to a location within a depository. Additionally, Buchanan does not teach receiving at a first institution an electronic package that comprises such a reference from a presenter. Rather, Buchanan teaches transferring

captured “deposit information and images of the monetary items” from a remote site to a financial institution (Buchanan, Col. 2, ll. 26 – 34). Claim 36 recites a similar limitation as Claim 3 and is also believed to be patentable over Buchanan for at least this reason.

Third, Claim 11 recites an initial step comprising “provisionally crediting an account of the presenter” and the method further comprises a step of “releasing the credited funds after recovery of the funds.” The Office Action asserts that “[being] credited to the depos[iting] individual’s account inherently after recovery of funds to change provisional” (Office Action, p. 4). What the cited passages actually teach appears to be “having those checks credited to the depositing individual’s . . . account” (Buchanan, Col. 3, ll. 53 – 54). However, first provisionally crediting an account and then releasing the credited funds clearly do not necessarily occur in a single step of crediting checks to an account. Hence, the Office Action has failed to establish inherency.

Fourth, Claim 16 recites “the financial instrument comprises a credit-card sales slip.” The Office Action appears to argue that “checks and deposit slips of any bank or credit cards” somehow teach a credit-card sales slip. Office Action, p. 5. At the cited passages, Buchanan does disclose that a depositor retains “the deposit slips” (Buchanan, Col. 2, l. 44). However, a credit-card sales slip is clearly not the deposit slip retained by a depositor. Clarification is respectfully requested.

Since at least some of the limitations recited in the independent claims and Claims 3, 11, 16, and 36 are not taught expressly or inherently by Buchanan, these claims are patentable over Buchanan. The various dependent claims are similarly patentable by virtue of their dependence from patentable claims.

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Appl. No. 09/971,726
Amdt. dated November 20, 2007
Reply to Office Action of August 20, 2007

PATENT

Respectfully submitted,

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